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EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/640,076

Applicant(s)

CAMPANA ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 94-262 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 94-96, 100-105, 108-111, 118-129, 131, 132, 136-141, 144-147, 154-157, 160, 164-169, 172-175, 182-193, 195, 196, 200-205, 208-211, 218, 219, 234-240, 242, 245-248, 250, 253-258, 260-265 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 97-99,106,107,112-117,130,133-135,142,143,148-153,158,159,161-163,170,171,176-181,194,197-199,206,207,212-217,220-233,241,243,244,249,251,252 and 259.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 97-99,106,107,112-117,130,133-135,142,143,148-153,158,159,161-163,170,171,176-180,194,197-199,206,207,212-217,220-233,241,243,244,249,251,252 and 259.

DETAILED ACTION

1. This action is in response to applicant's response filed on January 29, 2007. **Claims 94-96,100-105,108-111,118-126,128,129,131,132,136-141,144-147,1547-157,160,164-169,172-175,182-192,195,196,200-219,234-240,242,245-248, 250,253,254-258,260-265** are now pending in the present application.

Information Disclosure Statement

2. The information disclosure statement filed August 17, 2000 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it was not submitted with the USPTO 1449 form. Applicant has appeared to submit various previous 892 forms from the parent application as well has handwritten 1449 forms that are illegible and/or have already been initialed by a previous examiner. The examiner respectfully asks Applicants to resubmit a corrected 1449 form, which lists all references from the IDS filed on August 17, 2000, in response to this office action. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 94,234,242,250 and 258 are rejected under 35 U.S.C. 102(b) as being anticipated by Zabarsky et al. US Patent 4,644,351.

Regarding claim 94,234,242,250 and 258, Zabarsky teaches a system, computer program stored on a storage medium for execution by a system, method and a wireless device comprising a plurality of originating processors (paging units 106; fig. 1; fig. 10; each paging unit comprises a processor 1001), the originating processors originating electronic mail by executing electronic mail programming (col. 4, lines 56-64; col. 12, lines 30-49, fig. 11), the electronic mail containing an identification of an intended recipient and information which is transmitted in the electronic mail to the electronic mail system, (col. 11, line 68-col. 14, line 3; fig. 11),

a communication system including a system which receives electronic mail from the plurality of originating processors, (col. 5, lines 30-38; col. 15, lines 20-30),

a wireless system including at least one processor, (col. 15, lines 20-30; figs. 1 and 6),
at least one wireless device (paging unit 106), each wireless device including a wireless receiver (1025), a memory (1005) which stores the information contained in the electronic mail, a processor (1001) and at least one application program which is executed by the processor of the wireless device, (fig. 10, fig. 11; col. 12, lines 32-41; fig. 2); and

a processor, coupled to the communication system and to the wireless system, to which at least the information contained in the electronic mail is transmitted by the communication system, (col. 5, lines 30-38; col. 12, lines 32-41; fig. 2; fig. 6); and

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wherein the system which receives electronic mail determines if received electronic mail should be transmitted to the wireless system and, (col. 15, lines 62-col. 16, line 17), in response to reception of electronic mail which is determined to be electronic mail which should be directed to the wireless system, (col. 15, lines 62-col. 16, line 17), the system which receives electronic mail adds to at least the information contained in the electronic mail the identification of the at least one wireless device to receive at least the information (col. 15, lines 62-col. 16, line 17) and directs that at least the information and the identification of the at least one wireless device is transmitted to the processor coupled to the communication system and to the wireless system, (col. 15, lines 62-col. 16, line 17); and

in response to reception of at least the information contained in the electronic mail by the processor coupled to the communication system and to the wireless system, at least the information contained in the electronic mail and an identification of at least one wireless device which is to receive the information contained in the electronic mail are transmitted to the wireless system and by the wireless system through the at least one wireless system processor to the at least one wireless device with the processor thereof processing the information with the at least one application program, (col. 10, lines 27-41; col. 15, lines 62-col. 16, line 30).

5. Claims **94-96,100-105,108-111,118-126,128,129,131,132,136-141,144-147,1547-157,160,164-169,172-175,182-192,195,196,200-219,234-240,242,245-248, 250,253,254-258,260-265** are rejected under 35 U.S.C. 102(b) as being anticipated Mobile Data Network Description (TF Report 3/89), comprising volumes 1-4 and 6-8 published in 1989, hereinafter (Telenor).

Regarding claim 94, Telenor teaches a system comprising a plurality of originating processors, the originating processors originating electronic mail by executing electronic mail programming, the electronic mail containing an identification of an intended recipient and information which is transmitted in the electronic mail to the electronic mail system, (Telenor teaches of a communications system comprising a mobile data network ("MDN"), (vol. 1 - preface). Telenor teaches a wireless system (radio network comprising mobile stations), (vol. 1; figs. 1 and 2; pages 1-3). The communication system (MDN and MHS) transmit email into the communication system from various originating devices in both the MDN and MHS. For example regarding the MDN, the MS is extensively programmed to originate message (vol. 1, pages 45; vol. 7 - pages 6-7; vol. 8, pages 13-17,29). Regarding the MHS, a user inputs X.400 messages into the MHS at a user agent terminal (originating device), (vol. 8, pages 3-5; figs. 1,3 and 5). The MHS user agent terminal is a computer based device and thus comprises a processor that executes computer instructions. The X.400 messages are electronic mail message because X.400 messages contain an electronic envelope with content (to, from, subject) inside (vol. 8, page 6 - sec. 2.4), (vol. 8 sec. 7.1-7.1.5, pages 31-35);

a communication system including a system which receives electronic mail from the plurality of originating processors, (the communication system (MDN and MHS) transmit email into the communication system from various originating devices in both the MDN and MHS. For example regarding the MDN, the MS is extensively programmed to originate message (vol. 1, pages 45; vol. 7 - pages 6-7; vol. 8, pages 13-17,29). Further each MS comprises a "mobile" data terminal comprising a processor (vol. 7 - page 2; fig. 1). Thus the MS is a processor. The MDN MS originated message are electronic "mail" because the messages contain

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envelope type data (e.g., to, from, subject) and actual content (vol. 8, sections 7.1-7.1.5 - pages 31-33). Every message transmitted by a party is received by the MDN, (pages 39-42);

a wireless system including at least one processor, (the MS is extensively programmed to originate message (vol. 1, pages 45; vol. 7 - pages 6-7; vol. 8, pages 13-17,29). Further each MS comprises a “mobile” data terminal comprising a processor (vol. 7 - page 2; fig. 1). Thus the MS is a processor.);

at least one wireless device, each wireless device including a wireless receiver, a memory which stores the information contained in the electronic mail, a processor and at least one application program which is executed by the processor of the wireless device; and

Telenor teaches that certain MDN MS stations receive MDN and MHS originated messages, such as email, (vol. 2, pages 12-12). The MDN MS includes components such as a “Radio Protocol Controller” (“RPC”) and “radio unit” that form the claimed “wireless device” (vol. 7, page 2 fig. 1). The RPC and radio unit is a wireless receiver because the RPC and radio unit must function together integral as an overall RF receiver unit (vol. 7, fig. 1, page 2). The RPC/radio units (wireless devices) receive over the air broadcast for cellular based stations, (vol. 1, page 1; fig. 1). Also the wireless system also transmits message using a “broadcast mode”, (vol. 1, page 12, fig. 8). The MDN MS comprises a computer (vol. 7, page 2; fig. 1, processing unit) that fetches instructions (i.e. an application program) from memory in order to perform the disclosed functions.

a processor, coupled to the communication system and to the wireless system, to which at least the information contained in the electronic mail is transmitted by the communication system; and

The MDX interface is a computer based device performing multiple functions and supports a "distribution list" mode wherein the same message is transmitted to distribution lists of recipient addresses (vol. 1, pages 27-29), where the recipient address identifies the RF-receiver.

wherein the system which receives electronic mail determines if received electronic mail should be transmitted to the wireless system and, in response to reception of electronic mail which is determined to be electronic mail which should be directed to the wireless system, (vol. 1, page 11, page 41), the system which receives electronic mail adds to at least the information contained in the electronic mail the identification of the at least one wireless device to receive at least the information (vol. 1, pages 27-29) and directs that at least the information and the identification of the at least one wireless device is transmitted to the processor coupled to the communication system and to the wireless system, (vol. 1, page 22; fig. 12); and

The MDX receives an inbound message to a party which does not reside on that MDX and thus determines to relay the message to the home MDX of the addressed party, (vol. 1 page 22).

in response to reception of at least the information contained in the electronic mail by the processor coupled to the communication system and to the wireless system, at least the information contained in the electronic mail and an identification of at least one

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wireless device which is to receive the information contained in the electronic mail are transmitted to the wireless system and by the wireless system through the at least one wireless system processor to the at least one wireless device with the processor thereof processing the information with the at least one application program, (vol. 1, pages 11,21-22 and 25-26, fig. 12).

The MDX receiving a message addressed to a party relates the message to the addressed party's terminal. The MDT (wireless terminal) provides for operation control with a user interface and application program for processing the received message, (vol. 7, pages 4-7).

Regarding claim 95, Telenor, as applied to claim 94, teaches wherein the intended recipient is identified by a name of the intended recipient, (vol. 8, page 7).

Regarding claim 96, Telenor, as applied to claim 95, teaches the identification of the at least one wireless device is determined from the name of the intended recipient, (vol. 8, page 7).

Regarding claim 100, Telenor, as applied to claim 95, teaches wherein the system deletes information from the information contained in the electronic mail which deleted Information is not transmitted by the wireless system, (vol. 8, pages 43-45). Blind information teaches are preserved by the MDX and shall not be delivered to any MDN terminals.

Regarding claim 101, Telenor, as applied to claim 100, teaches wherein a processor in the system deletes the information from the information contained in the electronic mail (vol. 8, pages 43-45).

Regarding claims 102 and 105, Telenor, as applied to claims 101 and 104, teaches wherein the deleted information is a header (vol. 8, pages 43-45).

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Regarding claim 103, Telenor, as applied to claim 96, teaches wherein the system deletes information from the information contained in the electronic mail which deleted information is not transmitted by the wireless system (vol. 8, pages 43-45).

Regarding claim 104, Telenor, as applied to claim 103, teaches wherein a processor in the system deletes the information from the information contained in the electronic mail (vol. 8, pages 43-45).

Regarding claims 108, 110, 118, 120, 122, 124, 126 and 128, Telenor, as applied to claims 95, 96, 100, 101, 102, 103, 104 and 105 teaches wherein the processor coupled to the communication system and to the wireless system, after reception of the information contained in the electronic mail, adds additional information which is transmitted to the wireless system and at least the information contained in the electronic mail and the identification of the at least one wireless device are transmitted by the wireless system to the at least one wireless device, (vol. 1, pages 22, 27-29; fig. 12).

Regarding claims 109, 111, 119, 121, 123, 125, 127 and 129, Telenor, as applied to claims 108, 110, 118, 120, 122, 124, 126 and 128 teaches wherein the added information includes data packets which contain the information in the electronic mail, (vol. 1, pages 22, 27-29; fig. 12).

Regarding claims 131, 132, 136-141, 144-147 and 154-157, Telenor, as applied to claim 95, 96, 100-105, 108-111 and 118-121 teaches wherein one of the at least one wireless system processor, in response to information inputted thereto, determines a destination in the wireless system to which at least the information contained in the electronic mail and the identification of the at least one wireless device are transmitted by the wireless system and the wireless system at the destination wirelessly transmits at least the information and the identification of the at least

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one wireless device to the at least one wireless device, (vol. 1, pages 11,21-22 and 25-26, fig. 12).

Regarding claims 160,164-169,172-175,182-192,195,196 and 200-219, Telenor, as applied to claim 96,100-105,108-111,118-128,131,132,136-141,144-147,154 and 155 teaches wherein a check is performed by a processor in the system to determine if the information in the electronic mail should be transmitted by the wireless system, (vol. 1, page 11, page 41).

Regarding claim 234, Telenor teaches **a computer program stored on a storage medium for execution by a system which receives electronic mail included in a system coupled to a wireless system, wherein said electronic mail includes an identification of an intended recipient and information to be sent to the intended recipient from at least one originating processor which originates the electronic mail, wherein said wireless system receives at least said information included in the electronic mail and wirelessly transmits the at least said information included in the electronic mail to at least one wireless device as the intended recipient, and wherein said computer program when executed causes said system which receives electronic mail to perform the steps of:**

(Telenor teaches of a communications system comprising a mobile data network ("MDN"), (vol. 1 - preface). Telenor teaches a wireless system (radio network comprising mobile stations), (vol. 1; figs. 1 and 2; pages 1-3). The communication system (MDN and MHS) transmit email into the communication system from various originating devices in both the MDN and MHS. For example regarding the MDN, the MS is extensively programmed to originate message (vol. 1, pages 45; vol. 7 - pages 6-7; vol. 8, pages 13-17,29). Regarding the MHS, a user inputs X.400 messages into the MHS at a user agent terminal (originating device), (vol. 8, pages

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3-5; figs. 1,3 and 5). The MHS user agent terminal is a computer based device and thus comprises a processor that executes computer instructions. The X.400 messages are electronic mail message because X.400 messages contain an electronic envelope with content (to,from,subject) inside (vol. 8, page 6 - sec. 2.4), (vol. 8 sec. 7.1-7.1.5, pages 31-35).

receiving electronic mail from the at least one originating processor and determining if the electronic mail should be transmitted to the wireless system;

(the communication system (MDN and MHS) transmit email into the communication system from various originating devices in both the MDN and MHS. For example regarding the MDN, the MS is extensively programmed to originate message (vol. 1, pages 45; vol. 7 - pages 6-7; vol. 8, pages 13-17,29). Further each MS comprises a "mobile" data terminal comprising a processor (vol. 7 - page 2; fig. 1). Thus the MS is a processor. The MDN MS originated message are electronic "mail" because the messages contain envelope type data (e.g.. to, from, subject) and actual content (vol. 8, sections 7.1-7.1.5 - pages 31-33). Every message transmitted by a party is received by the MDN, (pages 39-42);

if the received electronic mail is to be transmitted to the wireless system, (vol. 1, page 11, page 41) adding to the at least said information included in the electronic mail an identification of the at least one wireless device which is to receive the information included in the electronic mail, (vol. 1, pages 27-29); and

transmitting from the system which receives electronic mail the at least said information included in the electronic mail and the identification of the at least one wireless device which is to receive the at least said information included in the electronic

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mail with the at said least information and the identification being received by said wireless system;

The MDX receiving a message addressed to a party relates the message to the addressed party's terminal. The MDT (wireless terminal) provides for operation control with a user interface and application program for processing the received message, (vol. 7, pages 4-7).

wherein said wireless system, responsive to receipt of the at least said information included in the electronic mail and the identification of the at least one wireless device from said system which receives electronic mail, wirelessly transmits the at least said information included in the electronic mail along with the identification of the at least one wireless device to permit receipt thereof by the at least one wireless device which executes an application program for processing the at least said information.

The MDX receiving a message addressed to a party relates the message to the addressed party's terminal. The MDT (wireless terminal) provides for operation control with a user interface and application program for processing the received message, (vol. 7, pages 4-7).

Regarding claim 235, Telenor, as applied to claim 234, teaches wherein a processor in the system deletes information from the electronic mail; and wherein the deleted information is not transmitted to said wireless system, (col. 8, lines 43-45).

Regarding claims 236 and 260, Telenor, as applied to claims 234 and 257 teaches wherein a processor in the system performs a check to determine if said information should be transmitted to said wireless system, (vol. 1, page 11, page 41).

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Regarding claims 237,245,253 and 261, Telenor, as applied to claims 234,242,250 and 257 teaches wherein said identification is a number serving as a mobile identification (ID) of the at least one wireless device, (vol. 8, page 7).

Regarding claims 238,246,254 and 262, Telenor, as applied to claims 237,245,253 and 260, teaches wherein said identification of the intended recipient included in the electronic mail is converted to said mobile ID, (vol. 8, page 7).

Regarding claims 239,247,255 and 263, Telenor, as applied to claims 234,242,250 and 257 teaches wherein a processor serving as an interface is coupled between said system and said wireless system, (Telenor teaches a wireless system (radio network comprising mobile stations), (vol. 1; figs. 1 and 2; pages 1-3). The communication system (MDN and MHS) transmit email into the communication system from various originating devices in both the MDN and MHS. For example regarding the MDN, the MS is extensively programmed to originate message (vol. 1, pages 45; vol. 7 - pages 6-7; vol. 8, pages 13-17,29).

Regarding claims 240,248,256 and 264, Telenor, as applied to claims 234,242,250 and 257, teaches wherein said application program executed by the at least one wireless device is electronic mail programming, (vol. 8, pages 3-5; figs. 1,3 and 5).

Regarding claim 242, Telenor teaches **a method in a system which receives electronic mail from at least one originating processor, said system which receives electronic mail being included in a system which is coupled to a wireless system, wherein said electronic mail includes an identification of an intended recipient and information to be transmitted to the intended recipient, wherein said wireless system receives at least said information included in the electronic mail and wirelessly transmits the at least said information**

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included in the electronic mail to at least one wireless device as the intended recipient, said method comprising:

(Telenor teaches of a communications system comprising a mobile data network (“MDN”), (vol. 1 - preface). Telenor teaches a wireless system (radio network comprising mobile stations), (vol. 1; figs. 1 and 2; pages 1-3). The communication system (MDN and MHS) transmit email into the communication system from various originating devices in both the MDN and MHS. For example regarding the MDN, the MS is extensively programmed to originate message (vol. 1, pages 45; vol. 7 - pages 6-7; vol. 8, pages 13-17,29). Regarding the MHS, a user inputs X.400 messages into the MHS at a user agent terminal (originating device), (vol. 8, pages 3-5; figs. 1,3 and 5). The MHS user agent terminal is a computer based device and thus comprises a processor that executes computer instructions. The X.400 messages are electronic mail message because X.400 messages contain an electronic envelope with content (to,from,subject) inside (vol. 8, page 6 - sec. 2.4), (vol. 8 sec. 7.1-7.1.5, pages 31-35);

receiving electronic mail at the system which receives the electronic mail from the at least one originating processor and determining if the electronic mail should be transmitted to the wireless system;

(the communication system (MDN and MHS) transmit email into the communication system from various originating devices in both the MDN and MHS. For example regarding the MDN, the MS is extensively programmed to originate message (vol. 1, pages 45; vol. 7 - pages 6-7; vol. 8, pages 13-17,29). Further each MS comprises a “mobile” data terminal comprising a processor (vol. 7 - page 2; fig. 1). Thus the MS is a processor. The MDN MS originated message are electronic “mail” because the messages contain envelope type data (e.g., to, from, subject)

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and actual content (vol. 8, sections 7.1-7.1.5 - pages 31-33). Every message transmitted by a party is received by the MDN, (pages 39-42);

if the received electronic mail is to be transmitted to the wireless system, the system which receives electronic mail adds to the at least said information included in the electronic mail an identification of the at least one wireless device which is to receive the information included in the electronic mail, (vol. 1, pages 27-29); and

transmitting from the system which receives electronic mail the at least said information included in the electronic mail and the identification of the at least one wireless device which is to receive the at least said information included in the electronic mail with the at least said information and the identification being received by said wireless system; and

The MDX receiving a message addressed to a party relates the message to the addressed party's terminal. The MDT (wireless terminal) provides for operation control with a user interface and application program for processing the received message, (vol. 7, pages 4-7).

wherein said wireless system, responsive to receipt of the at least said information included in the electronic mail and the identification of the at least one wireless device, wirelessly transmits the at least said information included in the electronic mail along with the identification of the at least one wireless device to permit receipt thereof by the at least one wireless device which executes an application program for processing the at least said information.

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The MDX receiving a message addressed to a party relates the message to the addressed party's terminal. The MDT (wireless terminal) provides for operation control with a user interface and application program for processing the received message, (vol. 7, pages 4-7).

Regarding claims 250 and 258, Telenor, teaches a system comprising:
at least one originating processor which originates electronic mail containing an identification of an intended recipient and information to be sent to the intended recipient from the at least one originating processor; (Telenor teaches of a communications system comprising a mobile data network ("MDN"), (vol. 1 - preface). Telenor teaches a wireless system (radio network comprising mobile stations), (vol. 1; figs. 1 and 2; pages 1-3). The communication system (MDN and MHS) transmit email into the communication system from various originating devices in both the MDN and MHS. For example regarding the MDN, the MS is extensively programmed to originate message (vol. 1, pages 45; vol. 7 - pages 6-7; vol. 8, pages 13-17,29). Regarding the MHS, a user inputs X.400 messages into the MHS at a user agent terminal (originating device), (vol. 8, pages 3-5; figs. 1,3 and 5). The MHS user agent terminal is a computer based device and thus comprises a processor that executes computer instructions. The X.400 messages are electronic mail message because X.400 messages contain an electronic envelope with content (to, from, subject) inside (vol. 8, page 6 - sec. 2.4), (vol. 8 sec. 7.1-7.1.5, pages 31-35);

a wireless system; Telenor teaches a wireless system (radio network comprising mobile stations), (vol. 1; figs. 1 and 2; pages 1-3).

at least one wireless device which executes at least one application program; Telenor teaches that certain MDN MS stations receive MDN and MHS originated messages, such as

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email, (vol. 2, pages 12-12). The MDN MS includes components such as a "Radio Protocol Controller" ("RPC") and "radio unit" that form the claimed "wireless device" (vol. 7, page 2 fig. 1). The RPC and radio unit is a wireless receiver because the RPC and radio unit must function together integral as an overall RF receiver unit (vol. 7, fig. 1, page 2). The RPC/radio units (wireless devices) receive over the air broadcast for cellular based stations, (vol. 1, page 1; fig. 1).

a communication system coupled to said wireless system; and (the communication system (MDN and MHS) transmit email into the communication system from various originating devices in both the MDN and MHS. For example regarding the MDN, the MS is extensively programmed to originate message (vol. 1, pages 45; vol. 7 - pages 6-7; vol. 8, pages 13-17,29). Further each MS comprises a "mobile" data terminal comprising a processor (vol. 7 - page 2; fig. 1). Thus the MS is a processor. The MDN MS originated message are electronic "mail" because the messages contain envelope type data (e.g., to, from, subject) and actual content (vol. 8, sections 7.1-7.1.5 - pages 31-33). Every message transmitted by a party is received by the MDN, (pages 39-42);

a system which receives electronic mail from the at least one originating processor, said system which receives electronic mail being included in said communication system, the electronic mail including said identification of the intended recipient and at least said information to be sent to the intended recipient, said system which receives electronic mail receives electronic mail from the at least one originating processor and determines if the electronic mail should be transmitted to the wireless system, if the received electronic mail is to be transmitted to the wireless system, adds to the at least said information included in

the electronic mail an identification of the at least one wireless device which is to receive the at least said information included in the electronic mail as the intended recipient, and transmits the at least said information included in the electronic mail and the identification of the at least one wireless device which is to receive the at least said information with the at least said information and the identification being received by said wireless system, (vol. 1, page 22; fig. 12); and

The MDX receives an inbound message to a party which does not reside on that MDX and thus determines to relay the message to the home MDX of the addressed party, (vol. 1 page 22).

wherein said wireless system, responsive to receipt of the at least said information included in the electronic mail and the identification of the at least one wireless device, wirelessly transmits the at least said information included in the electronic mail along with the identification of the at least one wireless device to permit receipt thereof by the at least one wireless device which executes the at least one application program for processing the at least said information, (vol. 1, pages 11,21-22 and 25-26, fig. 12).

The MDX receiving a message addressed to a party relates the message to the addressed party's terminal. The MDT (wireless terminal) provides for operation control with a user interface and application program for processing the received message, (vol. 7, pages 4-7).

Regarding claim 257 and 265, Telenor, as applied to claims 250 and 267 teaches wherein said communication system comprises another system which receives electronic mail; and the at least one wireless device receives electronic mail in the another system which receives electronic mail by executing electronic mail programming, (vol. 8, pages 3-5; figs. 1,3 and 5).

Response to Arguments

6. Applicant's arguments filed January 29, 2007 have been fully considered but they are not persuasive.

Zabarsky:

Applicant contends that Zabarsky does not teach or suggest of an electronic mail system which allows for electronic mail to be originated by executing electronic mail programming and the electronic mail being routed to a wireless device through a wireless system. The Examiner respectfully disagrees.

According to the Applicant, Zabarsky is simply directed to a wireless communication system which allows for wireless communication to be conducted between other wireless communication systems. The Examiner however, notes that in addition to wireless communication, Zabarsky also provides for sending electronic messages. Zabarsky specifically teaches of a plurality of paging units for originating e-mail messages¹.

In col. 4, lines 56-64, Zabarsky teaches that the network may connect to one or more public service database such as The Source or to data backbone networks such as DECnet or SNA. Zabarsky teaches that a pager may become a remote terminal for these types of services, sending and receiving data messages and information such as stock quotations or news service information.

¹ In the IDS filed on March 6, 2006, Applicant submitted a document (X.400 Breeds Third Generation E-Mail Systems, by J. Morris, TPT, Vol. 7, No. 3 Mar. 1989, pp 34-37) which defined electronic mail messages. Specifically the document states, "In its broadest definition, electronic mail encompasses communicating word processor, PCs, telex, facsimile, videotext, voicemail and radio paging systems (beepers)." Therefore, based on this definition, paging systems and the like, specifically read on e-mail systems.

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In col. 12, lines 29-47, Zabarsky teaches that the pager includes a microprocessor (which the Examiner interpreted the claimed originating processor to read on) and memory which is used to store incoming and locally generated messages. Zabarsky teaches that all messages are written as they are received or after the pager user generates and enters them.

In col. 13, lines 30-49, Zabarsky teaches of how the paging unit with the microprocessor (originating processor) generates a messages and transmits the message by entering the destination address of the message.

In col. 15, lines 5-23, Zabarsky teaches that after the "transmit" key is pressed, the message is encode in the transmission protocol and transmitted form the pager to the central site. The base transceiver receives the message and transfers it via the network control process to the PEX of the paging site.

In col. 15, lines 62-col. 16, line 17, Zabarsky teaches of the destination pager receiving the message wirelessly from the network.

Therefore, it is clear that Zabarsky teaches of a paging system (an electronic mail system (See above footnote)) which allows for messages (electronic mail) to be originated by a microprocessor in a paging unit which generates the messages (executing electronic mail programming) and the messages (electronic mail) being routed to a another pager (wireless device) through a wireless system as stated in the Office Action.

Applicant further contends that Zabarsky does not teach that the system which receives electronic mail determines if the received electronic mail should be transmitted to the wireless system or not. The Examiner respectfully disagrees.

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Throughout col. 15, line 61-col. 16, line 17, as noted in the Office Action, the system of Zabarsky makes numerous “determinations” for whether or not the e-mail should be transmitted to the wireless system or not.

For example, in col. 15, line 62-col. 16, line 4, Zabarsky teaches that when the message is received a determination is made as to whether or not the desired pager is in the roamer files or is logged in, and if so the NCP is activated to transmit the message to the desired pager.

In col. 16, lines 5-10, Zabarsky teaches of the steps that are executed if the pager address was not in the files.

Therefore, Zabarsky teaches of a system, which receives the message, determines whether or not the received message should be transmitted to the wireless system so that it can be transmitted to the desired user.

Therefore, regarding claims 94,234,242,250 and 258, the Examiner maintains that Zabarsky clearly anticipates the claims and thus the rejection is maintained.

Telenor:

a) The Telenor Documents Do No Qualify As Printed Publications Under 35 U.S.C.

102(b) Because They Have Been Manipulated and Altered Since Their Creation

Applicant contends that the Telenor Documents do not qualify as printed publications under 35 U.S.C. 102(b) because they have been manipulated and altered since their creation.

Applicant states that there are two sets of documents, i.e. a first set which was allegedly lodged at the Trondheim University Library in 1986 and 1989 and a second set which were retrieved from the Library in 2005 and in which was relied upon by the Examiner.

The Applicant stated that they have submitted the Declaration of David Richard Browne under 37 C.F.R 1.132 ("Browne Declaration") which details that the Telenor Documents cited by the Office have been significantly altered at some point subsequent to their creation.

The Examiner would like to first point out that the references have at least two indications of their effective date. For example vol. 1-vol. 2, vol. 4, vol. 6 of the report is dated Feb. 6, 1989 as shown in page 4 under "Dato" and the front page were hand stamped on Feb. 22, 1989. Vol. 3, vol. 7 and vol. 8 were hand stamped on April 24, 1989. Therefore, the Examiner relied upon the stamped dates for purposes of effective prior art date.

Furthermore, while the Applicant substantially provided excerpts from Browne's statement in this response, the Examiner points out that it appears that either the actual "Browne Declaration" was not properly entered into the record for this application because it has not been received or the Applicant inadvertently did not send the actual "Browne Declaration". The Examiner respectfully asks the Applicant to send or re-send the "Brown Declaration" so that it can be properly made of record.

The Examiner called Mr. Carl Brundidge around Feb. 15th, 2007, to inquire about the Browne declaration. Mr. Brundidge was going to look into the matter to see if his Office sent the declaration and if not, he was going to send the declaration. A subsequent call was made on Feb. 16th, and the Examiner left a message inquiring about the same issue. Since there does not appear to be any response from the office of Mr. Brundidge as of the date of this office action, the Examiner will not consider the Browne declaration on the merits.

Regarding the declaration of Kevin P.I Anderson:

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On page 18, Applicant cites a Declaration of Kevin P. Anderson, however, this declaration has not been supplied and thus cannot be treated on the merits. Furthermore, the Applicant states "The Office's citation to a letter from the Rector's Office at the Norwegian University of Science ("Letter") does not even address, let alone rebut, the Applicants' evidence that someone altered the Telenor Documents. The Examiner is unaware of any Office citation for this application which references the Rector's Office letter. The Examiner respectfully asks the Applicant when this letter was sent by them and when did the Examiner purportedly responded to this letter for the application.

Regarding the Rhyne Supplemental Declaration:

On page 23, Applicant cites use of the Rhyne Supplemental Declaration, however, this declaration has not been supplied and thus cannot be treated on the merits. Furthermore, there appears to be no mentioning of a first Rhyne declaration anywhere in the prosecution history of this instant application. Since Applicant is referencing a "supplemental", then there must be an original declaration.

b) The Telenor documents are not a printed publication because one skilled in the art of electronic mail communications system would not have located the Telenor Documents using reasonable diligence.

The Examiner respectfully disagrees. Since the Telenor documents relate to messaging in a wireless network system, then the Telenor documents are in the same field of endeavor, as this instant application and thus one of ordinary skill in the art would have located the Telenor Documents using broad search terms that are commensurate with both this instant application and the Telenor documents. Applicant relied upon the Rhyne declaration for support on whether

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or not one skilled in the art would have located the Telenor document. However, as shown above, the declaration does not appear to have been received by the Patent Office.

c) The Telenor documents fail to render any of the claims of the present application and d) the Telenor documents fail to anticipate all elements of the claims.

The Examiner would like to point out that it appears that Applicant did not respond to the current office action. The Applicant made numerous references to claimed limitations and pages of the Office Action and Examiner comments in the Office Action that do not appear in any way in this current office action.

For example:

On page 27, Applicant states that the Office Action points to the MDX as an “interface” that allegedly connects another hMDX and the MHS to the BS and MS of the MDN. The Examiner cannot locate where this statement is made in the current/previous office action.

On page 30, Applicant states that the Office Action alleges that the Telenor documents describe how the BS communicates with the Radio Unit/RPC control in page “43”. There is no page 43 to this office action.

On page 31, Applicant states that Telenor fails to disclose the “broadcasting the inputted message and the identification of the at least one designated RF receiver from the at least one broadcast location to the at least one designated RF receiver”. However, this limitation is not in any of the claims nor is it in the previous/current Office Action.

On page 32, Applicant states that the Office Action asserts that a single FT is “at least one electronic mail system”. The Examiner cannot locate where this alleged statement by the Examiner was made.

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On page 32, Applicant states that the Office action, without any specific citation, states that another port is connected via a modem to the RF information transmission system. However, there is no mentioning of a “modem” anywhere in the claims or in the office action.

There are numerous other recitations through the response including alleged use of inherency. The Examiner notes that, no inherency remarks were indicated in the current Office Action.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies, as shown above, are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner notes that it appears that Applicant inadvertently responded to the wrong Office Action, as stated above, since none of the references to the claims or alleged statements by the Office Action can be found for this instant Application.

Therefore, The Applicant's arguments are moot and are deemed unpersuasive with regards to whether or not Telenor anticipates the claims. The Examiner respectfully asks the Applicant to carefully re-review the Office action and re-present their arguments in any subsequent response which specifically addresses the Office Action so that the Examiner can adequately address the Applicant's concerns and arguments.

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Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7537, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER



Ovidio Escalante
Primary Patent Examiner
Group 2614
March 2, 2007

O.E./oe